

RECEIVED  
CENTRAL FAX CENTER  
FEB 28 2007

### REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants point out that a request for continued examination (RCE) is being filed along with this amendment. Therefore, no stringent showing under 37 CFR § 1.116(b) as to why this amendment is necessary and was not presented earlier is believed to be required.

Applicants respectfully request that this amendment as well as the amendment filed on October 3, 2006, be entered and considered.

Applicants also wish to thank SPE Woodward and Examiner Silverman for the courtesy of the interview recently accorded the undersigned. The substance of that interview as set forth in the Interview Summary of November 28, 2006, is agreed to. In addition, Applicants expand on the proposed amendments that were discussed as follows: First, an amendment was discussed to specify that teicoplanin is a free base. Second, an amendment was discussed to specify that the pharmaceutical preparation is dry. The first amendment was believed to be helpful in providing an additional selection criteria in Franz, wherein one of the ingredients would be used as the free base (teicoplanin) and the other would be used as the water-soluble salt (gentamicin, clindamycin, kanamycin, amikacin, tobramycin, vancomycin, moxifloxacin and ciprofloxacin.) The second amendment was believed to be helpful to provide a distinction as regards Franz's proposed mixtures, wherein the two components would come together in a solution.

USSN 10/600,557

6

Second Amendment under 37 CFR § 1.116 filed February 28, 2007

With respect to the first amendment, Applicants have confirmed that a "teicoplanin free base" does not exactly exist. Accordingly, Applicants have opted not to amend the claims in this manner.

With respect to the second amendment, Applicants have adopted the language. Thus, the claims have been amended above to specify that the pharmaceutical preparation is "dry." This language is amply supported by the entire disclosure, especially the examples, which show dry materials being ground together to prepare a pharmaceutical preparation, which is itself dry. Although the word "dry" is not used per se, a person having ordinary skill in the art would understand from the specification and the preparation examples that the pharmaceutical preparation is dry. Accordingly, it does not introduce new matter to say that the pharmaceutical preparation is what is self-evident, i.e., dry. In this regard, Applicants point out that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added *word* is a word that is used in the application as filed, but whether the *concept* embodied by the added word is present in the original specification as filed. *See, e.g., In re Anderson*, 176 USPQ 331, 336 (CCPA 1973).

Further along this same line, Applicants have added new claim 10, which is directed to a method of dry mixing the ingredients of claim 1. Again, this claim is also supported by the entire specification, and, especially, the examples.

Applicants do not believe that any of the amendments introduce new matter. An early notice to that effect is earnestly solicited.

Turning to the remaining issues, claim 9 was rejected under 35 USC § 112, second paragraph, as being indefinite. In response, as noted in the amendment of

USSN 10/600,557

7

Second Amendment under 37 CFR § 1.116 filed February 28, 2007

October 3, 2006, Applicants have amended claim 9 to recite what was originally intended, i.e., a method of treating a *bacterial* infection.

Claims 1, 2, 4, 5, 7 and 8 were rejected under 35 USC § 103(a) as being obvious over Franz et al. ("Franz"), US 5,797,873.

Claim 3 was rejected under 35 USC § 103(a) as being obvious over Franz in view of Pietsch, US 4,588,583.

Claim 6 was rejected under 35 USC § 103(a) as being obvious over Franz in view of Pratt et al. ("Pratt"), US 4,283,799.

Claim 9 was rejected under 35 USC § 103(a) as being obvious over Franz in view of Salaria, *Indian Pediatrics*, 38: 372-375 (2001).

In response to *all four* obviousness rejections, Applicants again respectfully submit that the Examiner has not made out a *prima facie* case of obviousness, particularly in view of the additional amendments made above. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw these rejections.

In order to make the claimed invention, a person having ordinary skill in the art must:

- 1) Select teicoplanin from Franz's list at the top of column 4 even though the bulk of Franz's disclosure is directed to the surprising properties of methotrexate, which is not even an antibiotic, but, instead, a cytostatic;
- 2) Select one of gentamicin, clindamycin and vancomycin from the same list for combination with teicoplanin even though Franz makes no mention of mixtures and, as noted above, the bulk of the disclosure relates to methotrexate;

3) Decide to use a water-soluble salt of one of gentamycin, clindamycin and vancomycin for combination with teicoplanin even though Franz does not mention such salts or any salts for that matter;

4) Decide to use teicoplanin in powdered form even though Franz makes no mention of powdered active ingredients although he does mention powdered polymers;

5) Decide the use the water-soluble salt of one of gentamycin, clindamycin and vancomycin also in powdered form even though, again, Franz says nothing about powdered active ingredients;

6) Decide to combine the two powders mentioned in 4) and 5) above first before mixing in organic solvent even though Franz teaches the first thing to do is to mix the active ingredient with the organic solvent; and

7) Dispense with the mixing with the organic solvent altogether in order to obtain a dry pharmaceutical preparation, as instantly claimed.

Applicants respectfully submit that Franz cannot possibly render prima facie obvious the instant claims are there are simply too many decisions that must be made by persons of ordinary skill in the art, and for which Franz provides absolutely no direction, in order to arrive at the instantly claimed subject matter. In view of the foregoing, Applicants respectfully submit that the Examiner should reconsider and withdraw all of the obviousness rejections.

Now repeating earlier arguments, in the last sentence on page 4 of the Office Action, the Examiner cites to the decision in *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980). This is to support a statement made by the Examiner earlier in the same paragraph, viz.:

“The motivation for combining them flows from their *having been* used individually in the prior art, and from them *being recognized in the prior art* as useful for the same purpose.”

Similar language can be found in *Kerkhoven* at page 1072.

A problem with the Examiner's attempt to rely on *Kerkhoven* here is that the Examiner has not demonstrated that what he says it would have been obvious to combine, given *Kerkhoven*, was known in the prior art, or recognized in the prior art as useful for the indicated purpose. Thus, while Franz mentions teicoplanin, gentamicin, clindamycin and vancomycin, Franz does not teach either powdery teicoplanin or powdery, water-soluble salts of gentamicin, clindamycin and vancomycin, which, in actuality, are what must “have been used individually in the prior art,” and must have “recognized in the prior art as useful for the same purpose” in order for the obviousness of their combination to fit in under *Kerkhoven*'s umbrella.

What the Examiner does is make a *first* hypothetical finding that powdery teicoplanin would have been obvious, and a *second* hypothetical finding that powdery gentamicin, clindamycin and vancomycin would have been obvious, and then a *third* further hypothetical finding that powdery, water-soluble salts of gentamicin, clindamycin and vancomycin would also have been obvious, and only then apply *Kerkhoven*'s premise, devoid of the underlying logic adduced above, to come to a *fourth* hypothetical finding that a combination of powdery teicoplanin and at least one powdery, water-soluble salt of gentamicin, clindamycin and vancomycin would also have been expected to be obvious. Respectfully, there are simply too many layers of supposition—one on top

of another on top of another on top of yet another—for this rejection to be tenable. The present rejection is not supported by the *Kerkhoven* logic, but, rather, runs far a field of it. Applicants respectfully submit that this is a classic hindsight rejection, which is improperly based on Applicants' disclosure and not the cited prior art and, therefore, must be withdrawn.

Granted, all prior art rejections are to some extent based on hindsight. However, impermissible hindsight occurs where selections are made not based solely on the cited references. This is what has occurred here. There is no express teaching in Franz that teicoplanin is used in a powdered form, and this is not inherent. (The Examiner uses the word "implicit," which has no legal correctness here. Disclosures are either express or inherent, and to be inherent, a disclosure must necessarily result from the prior art teachings. See, *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), for the proposition that inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference.) It is certainly not the case that, in the context of Franz's teachings, teicoplanin must necessarily be used in powdered form. Consequently, there is neither an express teaching nor an inherent teaching in Franz of powdered teicoplanin.

In like manner, there is no express or inherent teaching in Franz of powdered gentamicin, clindamycin and vancomycin, let alone of a powdered, water-soluble salt thereof. The Examiner has made a very colorful case why these forms would have been obvious, but such does not flow from the teachings of the prior art so, as a matter of law, they would not have been obvious.

Obviously, the Examiner views what Applicants have done as something rather straight-forward and routine. However, it is exactly in such situations that greater care must be taken to guard against prejudice induced by the simplicity of what Applicants have done.

As stated in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, (Fed. Cir. 1999):

“Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. **Close adherence to this methodology is especially important in the case of less technologically complex inventions**, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.’ ... **Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.** [Emphasis added.]”

Applicants submit that when a rigorous application of the requirement of a proper teaching or motivation to combine is made in the instant case, the Examiner’s house of cards folds. There simply is no way that a person having ordinary skill in the art, having to make all the selections and modifications in Franz’s disclosure that must be made in

USSN 10/600,557

12

Second Amendment under 37 CFR § 1.116 filed February 28, 2007

order to achieve the present invention, would actually have been led by Franz to make such selections and modifications to achieve the present invention with a reasonable expectation of success.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
NORRIS McLAUGHLIN & MARCUS, P.A.

By 

Kurt G. Briscoe  
Attorney for Applicant(s)  
Reg. No. 33,141  
875 Third Avenue - 18<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844